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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* LINDA ANN ROBERTS, EDWARD MICHAEL SILVER, and  
HONG THI NGUYEN

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Appeal 2008-1487  
Application 10/008,295  
Technology Center 3600

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Decided: September 24, 2008

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Before HUBERT C. LORIN, LINDA E. HORNER, and  
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3-7, 9-12, and 15. Claims 2, 8, and 13-14 have been

cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We  
AFFIRM.

## THE INVENTION

The Appellants' claimed invention is directed to processing an electronic request to purchase goods or services over a communication network. In one embodiment a server system allows a shopper to select a notification option when buying goods or services over a network which notifies the shopper of the occurrence of an event affecting the shopper's purchase (Specification 3:2-11). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method for processing an electronic request to purchase goods or services, the method comprising:
  - providing to a shopper, via a communications network, an electronic purchase order having an opportunity to select a notification option and provide electronic purchasing information, wherein the notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that affects the performance of delivery occurs;
  - receiving from the shopper, via the communications network, the electronic purchasing information that contains an electronic request to purchase goods or services and, if the notification option was selected, optionally supplied notification information, the notification information representative of at least one communication pathway for communicating with the shopper;
  - creating a shopper profile associated with the shopper, the shopper profile containing the

electronic request and the optionally supplied notification information;  
providing the shopper with delivery information;  
recognizing the occurrence of the triggering event that affects the performance of the delivery;  
accessing the notification information in the shopper profile;  
if the shopper has selected the notification option and supplied the notification information, notifying the shopper that the triggering event has occurred via the at least one communication pathway; and  
notifying the shopper of a changed delivery date.

## THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Fisher	US 2003/0149640 A1	Aug. 7, 2003
Ahluwalia	US 6,728,685 B1	Apr. 27, 2004

Rosenberg, *Presence: The Best Thing That Ever Happened To Voice*, <http://www.cconvergence.com/article/CTM20001023S0001>, (Nov. 2000) (herein referred to as the *Presence* article).

The following rejections are before us for review:

1. Claims 1, 3, 6, 7, 9, 12, and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ahluwalia and Fisher.
2. Claims 4, 5, 10, and 11 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ahluwalia, Fisher, and the *Presence* article.

## ISSUES

The first issue is whether Appellants have shown that the Examiner erred in rejecting claims 1, 3, 6, 7, 9, 12, and 15 under 35 U.S.C. § 103(a) as unpatentable over Ahluwalia and Fisher.

The second issue is whether Appellants have shown that the Examiner erred in rejecting claims 4, 5, 10, and 11 under 35 U.S.C. § 103(a) as unpatentable over Ahluwalia, Fisher, and the *Presence* article.

## FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence<sup>1</sup>:

FF1. Ahluwalia discloses a reporting system for online orders for consumer products. The consumer may select a means of reporting the vehicle delivery status and the frequency for the report. “For example, the consumer may elect to receive status update reports via email, ...” (Col. 10, ll. 30-32. The status update reports may provide an updated delivery date if it is changed from its original date due to changes in manufacturing or the transportation schedule (Col. 10:32-35).

FF2. Fisher discloses a system for providing order status information using a network. Periodically, an electronic mail messenger 15 checks a status database 16 to see if the status of any record has changed. If a record has been flagged, the mail messenger composes and transmits a message to the customer over the network [0021].

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<sup>1</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

## PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739, (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, . . . § 103 likely bars its patentability.” *Id.* at 1740. The operative question in this “functional approach” is thus “whether the

improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

## ANALYSIS

Before proceeding, we take this opportunity to point out that the Brief was filed (Sep. 11, 2006) before *KSR* issued (Apr. 30, 2007). Comments such as “the cited documents would not have supplied any motivation to combine them as suggested by the Action” (Br. 7) in arguing that the Examiner has not established a *prima facie* case of obviousness in the first instance reflect a standard for determining obviousness that was prevalent before *KSR* issued. *KSR* has since clarified the law on obviousness. *See* the Principles of Law *supra*. An expansive and flexible approach is to be taken.

*The rejection of claims 1, 3, 6, 7, 9, 12, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Ahluwalia and Fisher.*

The Appellants argued claims 1, 3, 6, 7, 9, 12, and 15 as a group (Br. 7). We select claim 1 as the representative claim for this group, and the

remaining claims 3, 6, 7, 9, 12, and 15 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Ahluwalia disclosed the claimed method except for “the notification is to be in the case of a triggering event; recognizing the occurrence of the triggering event; and notifying the shopper that the triggering event has occurred.” (Answer 4.) This indication of missing subject matter is referring to the claim limitations “providing to a shopper ... and electronic purchase order having an opportunity to select a notification option ... wherein the notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that effects the performance of the delivery occurs ... if the shopper has selected the notification information, notifying the shopper that the triggering event has occurred ... and the notifying the shopper of a changed delivery date” (claim 1). To meet these claim limitations, the Examiner relied on Fisher. According to the Examiner, “Fisher et al show that the notification is to be in the case of a triggering event; recognizing the occurrence of the triggering event; and notifying the shopper that the triggering event has occurred.” (Answer 4.) The Examiner determined that “[i]t would have been obvious to one of ordinary skill in the art to modify the method of Ahluwalia as taught by Fisher et al in order to provide information to the buyer when the status of the order has been updated.” *Id.*

We are satisfied that the Examiner has presented a prima facie case obviousness that includes an articulation of an apparent reason, with logical underpinning, for combining the prior art to reach the claimed subject matter.



The Appellants disagree. The Appellants make three arguments: (a) the cited prior art does not describe or disclose all the claimed limitations, (b) there is no suggestion to combine the prior art to reach the claimed subject matter, and (c) there is no reasonable expectation that the prior art could be successfully combined. (Br. 7.)

*(a) the cited prior art does not describe or disclose all the claimed limitations*

The Appellants do not contest the Examiner's characterization of the scope and content of Ahluwalia. (Br. 8.) Nor do the Appellants challenge the Examiners' finding as to the claimed subject matter missing from Ahluwalia. *Id.* Rather, the Appellants challenge the Examiner's reliance on Fisher to show the missing subject matter is disclosed in the prior art. According to the Appellants, "all that Fisher states about notifications is that they occur at every status change, whatever that change might be, and without request by the customer." *Id.* In other words, according to Appellants,

Fisher's notifications say nothing about and would not have suggested any of notifying only in response to customer selection and only in case of triggering events that affect performance of deliveries, or recognizing triggering events that affect performances of deliveries or, perforce, notifying that such triggering events have occurred.

*Id.*

As a preliminary matter, the Appellants' suggestion that the claimed process requires notifying *only* in response to customer selection and *only* in case of triggering events that affect performance of deliveries is not commensurate in scope with what is claimed. The claimed method is in no

way so limited. The method claimed describes the manner by which a shopper may, if desired, select an option to receive a notification. Nothing in the claim makes notification dependent on the shopper's selection of the option to be notified. The breadth of the claim is such that notification could occur even if the option is *not* selected and/or the triggering event does *not* occur.

Furthermore, we find Ahluwalia sufficient as evidence that the prior art discloses the claim limitations in dispute.

The claim limitations in dispute are “providing to a shopper ... an electronic purchase order having an opportunity to select a notification option ... wherein the notification option, if selected, indicates that the shopper desires to be contacted if a triggering event that effects the performance of the delivery occurs ... if the shopper has selected the notification option and supplied the notification information, notifying the shopper that the triggering event has occurred ... and notifying the shopper of a changed delivery date” (claim 1).

A broad question to be answered is whether the prior art would lead one of ordinary skill in the art to a method comprising providing and receiving electronic purchasing information with a notification option. In that regard, Ahluwalia discloses a process of ordering a vehicle involving online orders and whereby a consumer may select to receive a report of vehicle delivery status (e.g., a vehicle's updated delivery date) and a frequency for that report. The consumer may elect to receive status update reports via email, for example. (FF1.) In broad terms, this disclosure describes a process for providing and receiving electronic purchasing information that includes a notification option.

However, in describing that a consumer may select to receive a report, Ahluwalia necessarily describes the embodiment, covered by the claim, whereby the consumer has *selected* the notification option (and indicating thereby a desire to be notified when a triggering event occurs). Furthermore, in describing that one result of selecting the notification option might be the delivery of status reports to the consumer of, for example, a vehicle's delivery date, Ahluwalia necessarily describes the embodiment, covered by the claim, whereby, having selected the notification option, a shopper is contacted (e.g., via email) when a triggering event (e.g., change in delivery date) effecting performance of the delivery (in Ahluwalia's case, delivery of the vehicle on a preset date) occurs. (It follows that this necessarily presumes a shopper's prior *desire* to be contacted if the triggering event (e.g., change in delivery schedule) effecting the performance of the delivery occurs.)

That leaves only the matter of whether the prior art would lead one of ordinary skill in the art to a process where "if the shopper has selected the notification option and supplied the notification information, *notifying the shopper that the triggering event has occurred ... and [ ] notifying the shopper of a changed delivery date*" (claim 1, emphasis added). As for the limitation "notifying the shopper that the triggering event has occurred," given that the Ahluwalia method would notify the consumer upon a change in delivery schedule, the change in delivery schedule acts as a triggering event for the notification. Concomitant with the notification of the change in delivery schedule is a notification that the triggering event (change in schedule) has occurred. As for the limitation "notifying the shopper of a changed delivery date," given that Ahluwalia discloses the possibility that a

consumer may elect to receive a report of a vehicle's updated delivery schedule (FF1), Ahluwalia necessarily meets this limitation.

Accordingly, we find that Ahluwalia discloses the disputed limitations in the claim.

While our reasoning differs from the Examiner, we will sustain the rejection and *not* denominate the rejection as a new ground. The Appellants were given an opportunity to address all the prior art the Examiner used as evidence to reject the claim as being obvious under § 103 but chose to limit the argument to Fisher. Had Ahluwalia been read more closely, it would have been evident that Ahluwalia describes the claimed process. Patents are “relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983). While our reasoning may appear to support rejecting claim 1 under § 102 rather than § 103, that does not necessitate making a new ground under §102. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for “anticipation is the epitome of obviousness.” *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984). *See also In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982); *In re Pearson*, 494 F.2d 1399, 1402 (CCPA 1974). The Examiner's determination that the claimed method would have been obvious to one of ordinary skill in the art at the time the application was filed is supported by Ahluwalia alone. The fact that we rely on less than all of the references the Examiner applied does not warrant a new ground of rejection. *In re Bush*, 296 F.2d 491,496 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 (CCPA 1966).

Accordingly, for the foregoing reasons, we do not find the Appellants' arguments that the cited prior art does not describe or disclose all the claimed limitations persuasive as to error in the rejection.

*(b) there is no suggestion to combine the prior art to reach the claimed subject matter*

The Appellants further argue that there is no motivation to combine Ahluwalia and Fisher because they teach away from the combination (Br. 9). As Ahluwalia alone discloses all the limitations of claim 1 for the reasons discussed *supra*, a reason to combine Ahluwalia and Fisher is unnecessary. Accordingly, this argument is not persuasive.

*(c) there is no reasonable expectation that the prior art could be successfully combined*

Finally, the Appellants argue that the two references would not be combined because the "great technical differences between them" would have made such a combination improbable (Br. 9-10). As Ahluwalia alone discloses all the limitations of claim 1 for the reasons discussed *supra*, discussion as to whether there is a reasonable expectation of producing a successful result from combining Ahluwalia and Fisher is unnecessary. Accordingly, this argument is not persuasive.

Having addressed all the arguments contesting the Examiner's prima facie case of obviousness for the subject matter of claim 1 and finding them unpersuasive as to error in the rejection, and there being no evidence of secondary considerations of nonobviousness for our consideration, the rejection is sustained. Given that claim 3, 6-7, 9, 12, and 15 stand or fall with claim 1, their rejection is sustained for the same reasons.

*The rejection of claims 4, 5, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Ahluwalia, Fisher, and the Presence article.*

With regards to the rejection of claims 4-5 and 10-11 under 35 U.S.C. § 103(a) as unpatentable over Ahluwalia, Fisher, and the *Presence* article the Appellants have only argued the same issues addressed above. Accordingly the rejection of these claims is also sustained for the same reasons as those given above.

### CONCLUSIONS

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 1, 3, 6, 7, 9, 12, and 15 under 35 U.S.C. § 103(a) as unpatentable over Ahluwalia and Fisher.

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 4, 5, 10, and 11 under 35 U.S.C. § 103(a) as unpatentable over Ahluwalia, Fisher, and the *Presence* article.

### DECISION

The Examiner's rejection of claims 1, 3-7, 9-12, and 15 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

### AFFIRMED

Appeal 2008-1487  
Application 10/008,295

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